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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,238	12/28/2000	Paula Dorf	203-004	8600

7590 01/28/2003  
Ward & Olivo  
708 Third Ave  
New York, NY 10017

EXAMINER

COMSTOCK, DAVID C

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 01/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Applicati n No.

09/753,238

Applicant(s)

DORF, PAULA

Examin r

David C. Comstock

Art Unit

3732

-- Th MAILING DATE of this communication app ars on th cover sh et with the correspond nce address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 5-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, and 5-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |                                                                                              |                                                                             |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:                                          |

## DETAILED ACTION

### *Drawings*

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1, 7, 8, 14, and 16-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Dorf.

Dorf discloses a cosmetic brush 93 comprising a tapered handle attached to a ferrule 23 and a tuft 33 of fibrous bristles 25 having a root end and a tip end 83. The tuft of bristles is aligned to have a curved shape along the width. The ferrule secures the handle to the root end of the tuft. The handle can be made from a variety of materials including metal or plastic. The ferrule can be made from tin, tin alloy, steel, aluminum, or plastic. The bristles can be formed from synthetic nylon or from hair. (See Fig. 3A; col. 3, lines 39-44 and 57-60; and col. 5, lines 24-34.)

***Claim Rejections - 35 USC § 103***

Claims 1, 3, and 5-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cervantes (4,222,677) in view of Dorf (6,039,051) and Gueret (5,357,647).

Cervantes discloses an eyeliner brush 10 comprising a tapered handle 12 and a tuft 14 of bristles having a root end and a tip end and having bristles of substantially the same lengths. The handle is made from rigid materials such as wood, metal, or plastic and the bristles are made from conventional materials. (See Figs. 1 and 2; col. 1, line 10; and col. 2, lines 2-8.) Cervantes does not disclose the ferrule or the bristle tuft being aligned to have a generally curved shape along the width. Dorf discloses a cosmetic brush 93 having a ferrule 23 to retain a tuft 33 of bristles 25 (see Fig. 3a and col. 3, lines 55-57). Gueret discloses a semi-elliptical cosmetic brush 1 having a tuft T of bristles aligned to have a generally curved shape S3 along the width to conform to the shape of the user's body and facilitate the application of a cosmetic product. The width of the cross section of the tuft of bristles is greater than twice the thickness. (See Fig. 10 and col. 3, lines 62-64.) It would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the brush of Cervantes using a ferrule to attach the tuft to the handle instead of attaching the bristles directly to the handle in view of Dorf, as such would merely constitute substitution of functionally equivalent means, known in the art, of attaching tufts of bristles to brush handles. It would have been further obvious to one having ordinary skill in the art at the time the invention was made to provide a tuft of bristles aligned to have a generally curved shape along the width, in view of Gueret, in order to conform to the shape of the user's

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body and facilitate application of the cosmetic product. With regard to claims 9-12 and 15, it would have also been obvious to one having ordinary skill in the art at the time the invention was made to form the handle from aluminum, steel, tin, tin alloy, or bamboo, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. With regard to claims 16-21, it would also have been obvious to one having ordinary skill in the art at the time the invention was made to form the ferrule from tin, steel, aluminum, tin alloy, or plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. With regard to claims 23-25, it would have also been obvious to one having ordinary skill in the art at the time the invention was made to form the bristles from a fibrous synthetic nylon and/or hair, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. With regard to claim 26, Cervantes discloses a method of applying eyeliner comprising applying eyeliner to the tip end of the brush, positioning the tip end sequentially on a plurality of locations on the lashbed, and moving the tip in a side-to-side motion on the locations, i.e., "stroking the brush at the desired location" (see Fig. 1; col. 1, lines 10, 19-24, 43-46; and col. 2, lines 20-25 and 30-32). Cervantes does not disclose "firmly" positioning said tip end. It would have been obvious to one having ordinary skill in the art at the time the invention was made to position the tip end "firmly," "softly," or with any

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of various levels of force since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. The curved tip end would inherently meet the skin of the lashbed since the device of Cervantes, as modified by Dorf and Gueret, is directed to the application of eyeliner, which necessarily "meets the skin" of the lashbed when it performs its function of lining the skin at the bed of the eyelashes.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Nevertheless, insofar as applicant's arguments still apply, the following is noted.

In response to applicant's argument that Dorf (6,039,051) does not anticipate applicant's invention, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Dorf is at least "capable" of performing the intended use. It is further noted that Dorf meets applicant's claim language inasmuch as the bristles of Dorf are aligned and form a generally curved shape along their width.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's arguments that there is no motivation to combine the teachings of the references, it is noted that it is not necessary that the references actually suggest, expressly or in so many words, the changes or improvements that applicant has made. The test for combining references is what the references as a whole would have suggested to one of ordinary skill in the art. *In re Sheckler*, 168 USPQ 716 (CCPA 1971); *In re McLaughlin*, 170 USPQ 209 (CCPA 1971); *In re Young*, 159 USPQ 725 (CCPA 1968). Similarly, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Here, the references as a whole and the knowledge generally available to one of ordinary skill in the art would certainly suggest to use functionally equivalent means of attaching bristle tufts to handles.

**Conclusion**

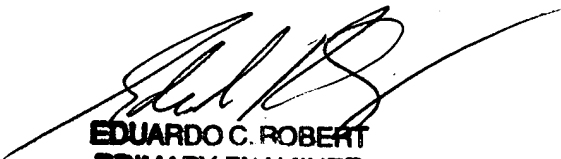
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Applicant amended the claims to require that the tuft of bristles be aligned to form a generally curved shape along their width and to have the same length. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Comstock whose telephone number is (703) 308-8514.

OC

D.C. Comstock  
January 25, 2003

  
**EDUARDO C. ROBERT**  
**PRIMARY EXAMINER**